

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today  
(1) was not written for publication in a law journal and  
(2) is not binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte THOMAS J. BATE  
and HUGH C. WILSON

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Appeal No. 95-4577  
Application 08/001,192<sup>1</sup>

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HEARD: Mar. 11, 1999

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Before GARRIS, WEIFFENBACH, and KRATZ, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

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<sup>1</sup> Application for patent filed January 7, 1993.

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This is a decision on an appeal which involves claims 3 through 6, 8, 10 through 17 and 25 through 29.<sup>2</sup> The only other claims remaining in the application, which are claims 18 through 24, have been allowed.

The subject matter on appeal relates to a non-stick coating which comprises refractory fibres mixed with at least one fluorocarbon resin and to a cooking article having such a non-stick coating. This appealed subject matter is adequately illustrated by independent claims 25, 27, 28 and 29, a copy of which taken from the appellants' brief is appended to this decision.

The sole reference relied upon by the examiner as evidence of obviousness is:

Yoshimura et al.	4,248,763	Feb. 3, 1981
(Yoshimura)		

All of the claims on appeal are rejected under 35 U.S.C. § 103 as being unpatentable over Yoshimura.

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<sup>2</sup> As pointed out by the examiner in his answer and noted by the appellants' attorney during the oral hearing, claims 8 and 10 inappropriately depend from canceled claims. This informality should be corrected upon return of the application to the jurisdiction of the examiner.

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We refer to the brief and to the answer for a complete exposition of the opposing viewpoints expressed by the appellants and the examiner concerning this rejection.

#### OPINION

Because the examiner has failed to carry his initial burden of establishing a prima facie case of obviousness, the above noted rejection can not be sustained.

According to the examiner, the non-stick characteristic recited in the appealed claims would be inherently possessed by the composition of Yoshimura. It is well settled, however, that an examiner must provide some evidence or scientific reasoning to establish the reasonableness of his or her belief that the functional limitation of a claim, such as the here claimed non-stick feature, is an inherent characteristic of the prior art. Ex parte Skinner, 2 USPQ2d 1788, 1789 (Bd. Pat. App. & Int. 1986). In the case before us, the examiner has advanced no such evidence or reasoning and thus has failed to establish a prima facie case for his inherency position.

With regard to the here claimed coating thickness limitation of up to 50 microns, the examiner simply states that "[t]he [Yoshimura] composition can be applied such as

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coatings having thickness of a film of 50 microns" (answer, page 7; emphasis added). The mere fact that patentee's "composition can be applied" at a thickness of 50 microns is, by itself, inadequate to establish obviousness. This is because the capability of so modifying the prior art would not have made the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984). In this latter regard, the appellants are correct that the Yoshimura reference would have militated against rather than for such a thickness (e.g., see the last full paragraph in column 1 and the paragraph bridging columns 1 and 2 of the patent).

Finally, the examiner has failed to establish a prima facie case with the respect to the cooking article feature of appealed claim 29. While the examiner seems to appreciate that claim 29 contains such a feature (see the second full sentence on page 8 of the answer), he has offered no evidence or reasoning in support of a conclusion that it would have been obvious to so modify the subject matter of Yoshimura as to result in a cooking article as required by the claim under

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review. In the absence of even an attempt to provide the requisite evidence or reasoning to support an obviousness conclusion, it appears to us that the examiner has failed to even shoulder much less carry his initial burden.

In light of the foregoing, the examiner's section 103 rejection of the appealed claims as being unpatentable of Yoshimura can not be sustained.

The decision of the examiner is reversed.

REVERSED

	Bradley R. Garris	)	
	Administrative Patent Judge	)	
		)	
		)	
		)	
	Cameron Weiffenbach	)	BOARD OF
PATENT		)	
	Administrative Patent Judge	)	APPEALS AND
		)	INTERFERENCES
		)	
		)	
	Peter F. Kratz	)	
	Administrative Patent Judge	)	

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APPENDIX

25. A coating composition for providing a non-stick coating which comprises refractory fibres mixed with at least one fluorocarbon resin, wherein said refractory fibres represent 1 to 25% by weight of a final coating derived from said composition and said refractory fibres have diameters in the range of about 1 Fm to 20 Fm and lengths in the range of about 70 Fm to 150 Fm, and wherein said at least one fluorocarbon resin represents 40 to 90% by weight of said final coating, wherein said final coating is adapted to be a non-stick coating.

27. A coating formulation for providing a non-stick coating on a metal substrate for the manufacture of cookware, said coating composition comprising: a liquid medium present as about 40 to 60% by weight of said coating formulation, said liquid medium being selected from the group consisting of water, xylene, toluene, N-methyl pyrrolidine, dimethyl formamide, glycol and alcohol, refractory fibres dispersed in said liquid medium, said refractory fibres representing about 1 to 25% by weight of a final coating derived from said



formulation, said refractory fibres being selected from the group consisting of aluminum fibres, glass fibres and carbon fibres; said refractory fibres having a diameters in the range of about 1 Fm to 20 Fm and having lengths in the range of about 70 Fm to 150 Fm; and at least one fluorocarbon resin dispersed or dissolved in said liquid medium, said fluorocarbon resin being selected from the group consisting of polytetrafluoroethylene, fluorinated ethylene propylene, perfluoroalkoxy and combination thereof, said fluorocarbon representing about 40 to 90% by weight of said final coating.

28. A non-stick coating comprising a film of thickness up to about 50 Fm, said film comprising at least one fluorocarbon resin and refractory fibres, said refractory fibres having diameters in the range of about 1 Fm to 20 Fm and lengths in the range of about 70 Fm to 150 Fm.

29. A cooking article comprising a substrate and non-stick coating, said non-stick coating comprising a film of thickness up to about 50 microns, said film comprising at least one fluorocarbon resin and fibres.

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